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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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1001 CONNECTICUT AVENUE NW
WASHINGTON DC 20006

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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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176J

DATE MAILED:

03/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/487,000

Applicant(s)

BROCKEL ET AL.

Examiner

Helen F. Pratt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☒ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 17) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 10 recites the broad recitation "wherein polyethylene glycols....or C3-C14", and the claim also recites "citric acid....and their salts" which is the narrower statement of the range/limitation.

Claim 16 provides for the use of impregnated salts, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process

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applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is indefinite in the use of the phrase "formulation auxiliaries". It is not known what is meant by this phrase.

Claim 16 is indefinite in the use of the phrase "or of the preservative for acid treatment". It is not known what is meant by this phrase.

Specification

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(1). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

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The use of the trademarks SIPERNATS, TIXOSITS OR AEROSILS (page 8, lines 1-3 have been noted application and throughout the application. They should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over van Ooijen (GB 0 608 975 A) or Gonthier et al. or Kotani et al.

Ooijen disclose a composition containing an alkaline earth metal hydroxycarboxylate and a carboxylic acid (page 2, lines 20-56 and page 3, lines 1-15). Claims 1-3, 5, 16 differ from the reference in the particular amount of acid in the product. The reference discloses 1-90%, preferably 40-60% hydrocarboxylic acid (page 3, lines 16-21). No patentable distinction is seen at this time in the range of 0.5 to 30% absent a showing of unexpected results. Gonthier et al. disclose an impregnated salt containing like acid and salts (col. 1, lines 41-69 in amounts from 0.1 to 100/1 (col. 1,

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lines 64-68) as in claims 1, 2, 3, 4, 5, 6). Gonthier et al. also differ from the reference in the particular amounts used. Kotani et al. disclose the use of the claimed salts and acid (abstract) as in claims 1, 2, 4, 5, 6, 7 (and col. 1, lines 58-70, col. 4, lines 5-70). Therefore, it would have been obvious to use amounts within the claimed amounts.

Claim 4 requires that the same carboxylic acid and the same carboxylic acid salt is required. The reference to Ooijen discloses using an alkaline earth metal carboxylate of a hydroxycarboxylic acid and another acid, which does not exclude using the same salt which would breakdown to the same acid. Therefore, it would have been obvious to use salts which give the same acid.

Claim 6 further requires that the impregnated salt is a preservative. As the claimed ingredients are disclosed by Ooijen, it is seen that it has as much preservative effects as that claimed. Therefore, it would have been obvious to make a composition containing the claimed ingredients which inherently would have had the same preservative effects.

Claim 8 further requires a protective agent which is soluble or swellable in water at 20°C. The glycerin of Kotani et al. is well known to be soluble in water at 20°C. Therefore, it would have been obvious to use glycerin as a protective agent.

Claims 9 and 10 require that various agents can be protective agents. Kotani et al. disclose that lactic acid and propylene glycol or ethylene glycol have been added to the double salts (col. 4, lines 25-45). Therefore, it would have been obvious to add known protective agents to the double salts.

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Claim 11 requires dusting powders. The specification discloses that these salts are known and have trade names. It is seen that dusting powders are well known and here are used for their known function of keeping materials separate. Therefore, it would have been obvious to use known dusting powders for their known functions.

Claim 12 is to the method of impregnating a carboxylic acid salt with an acid to a particular concentration. Kotani et al. disclose dissolving acids in ethanol and then adding a carboxylic acid salt (col. 2, lines 43-64). As the acid is mixed with the salt, it is seen that it is impregnated. Van Ooijen discloses that the acids can impregnate the carboxylate salt (page 3, lines 10-15). Claim 12 differs as in the composition claim in the particular amount of acid added. The discovery of an optimum value of a result effective variable is ordinarily within the skill of the art. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). In developing a preservative, properties such as stability and shelf life are important. It appears that the precise ingredients as well as their proportions affect the stability and shelf life of the product, and thus are result effective variables which one of ordinary skill in the art would routinely optimize. Therefore, it would have been obvious to use amounts within the range of the reference for their known function of making an impregnated stable salt.

The further limitations of claims 14-15 have been discussed above and are obvious for those reasons.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano can be reached on (703) 308-1978. The fax phone number for the organization where this application or proceeding is assigned is 703-873-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

Hp 2-28-01

H. Pratt
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